

REMARKS

Claims 1-41 are pending in this application. Claims 1, 21, and 41 are amended herein. Support for the amendments to the claims may be found in the claims as filed originally, as well as at page 6, lines 15-27, continuing at page 7, lines 1-9, and page 11, lines 14-22, Reconsideration is requested based on the foregoing amendment and the following remarks.

Response to Arguments:

The Applicant acknowledges with appreciation the consideration of the arguments filed on March 31, 2006. The Office Action relates in section 3, at page 2, that:

Applicant's arguments with respect to claims 1-41 have been considered but are moot in view of new grounds of rejection.

A careful review of the subject grounds of rejection, however, indicates that they are substantially identical to those of the final Office Action mailed June 27, 2005. The Applicants thus request a substantive response to the Arguments filed March 31, 2006, and a reason as to why the amendments filed then did not overcome the subject grounds of rejection.

The grounds in the final Office Action mailed June 27, 2005 were, furthermore, substantially identical those of the Office Action mailed September 13, 2004. Rather, as discussed in the telephone conference of August 17, 2005, there are apparently no new grounds of rejection in the final Office Action, and the Examiner agreed to remove the finality of the Office Action mailed June 27, 2005 upon receipt of a further response from the Applicant. This did not happen. Rather, an Advisory Action was mailed December 2, 2005 in response to the Applicant's response filed September 27, 2005.

The Applicants have thus filed three amendments and/or responses in good faith, and received substantially the same grounds in response to each, *with no explanation as to why the arguments and amendments failed to overcome the grounds of rejection*. Reconsideration of the arguments filed herein, as well as those filed March 31, 2006, as well as a response thereto, is thus requested.

Claim Rejections - 35 U.S.C. § 103:

Claims 1-41 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,265,033 to Vajk et al., (hereinafter "Vajk") in view of U.S. Patent No. 6,085,177 to Semple et al., (hereinafter "Semple") and further in view of K. Furuta, Japanese Patent Laid-

Open Publication No. HEI 7-319975 (hereinafter "Furuta"). The rejection is traversed, to the extent it might apply to the claims as amended. Reconsideration is earnestly solicited.

The second clauses of claims 1 and 21 recite:

A first ATM having a message input section to input a message during a remittance financial transaction so that the message is transmitted to a remittance destination after the remittance financial transaction.

Neither Vajk, Semple, nor Furumoto teach, disclose, or suggest "a first ATM having a message input section to input a message during a remittance financial transaction so that the message is transmitted to a remittance destination after the remittance financial transaction," as recited in claims 1 and 21. Thus, even if the references were combined as proposed in the Office Action, the claimed invention would not result.

The fourth clauses of claims 1 and 21 recite, substantially:

A message depository, communicably connected with said first ATM via a public communications network that is separate from the exclusive line, storing the message input by said message input section of said first ATM.

Neither Vajk, Semple, nor Furumoto teach, disclose, or suggest a "message depository, communicably connected with said first ATM via a public communications network that is separate from the exclusive line, storing the message input by said message input section of said first ATM," as recited substantially in claims 1 and 21. The Office Action acknowledges this deficiency with respect of Vajk graciously in the first full paragraph at page 4:

Vajk does not disclose communication network is public communications network comprises Internet or Intranet (claims 18-19), that is separate from the exclusive line, and the associated depository information indicates a site where message is stored in message depository.

The Office Action seeks to compensate for this deficiency of Vajk by combining Vajk with Semple, saying in the first full paragraph at page 4 that:

Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify the Vajk's ATM machines to include Internet access feature for the purpose of providing more convenient for the many users can access to the Internet at ATM machine, not just at home, to perform many Internet transaction such as using electronic mail message.

M.P.E.P. § 2143.01, however, prohibits a proposed modification that would render a reference unsatisfactory for its intended purpose. As provided therein:

If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation

to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

In this case, one intended purpose of Vajk is to provide a secure system for public access to electronic mail services. To ensure a secure system, Vajk avoids the Internet entirely. In particular, as described at column 2, lines 12-18:

The system of the present invention employs unique peripherals in conjunction with parts of existing communications networks and devices to provide simple text communications to remote locations. It provides this service by means of a structured link between a store and forward message switch and other already installed communication systems.

Vajk, thus, rejects the Internet in favor of a structured link between a store and forward message switch and other already installed communication systems.

Communication over the Internet, on the other hand, while satisfactory for most uses, will not be as secure as communication over the "structured link between a store and forward message switch and other already installed communication systems," provided by Vajk. Since modifying Vajk to include Internet access as proposed in the Office Action would render Vajk unsatisfactory for its intended purpose of providing a "structured link between a store and forward message switch and other already installed communication systems," there is no suggestion or motivation to make the proposed modification, *In re Gordon*.

It is submitted, therefore, that persons of ordinary skill in the art who read Vajk for all it contains at the time the invention was made would have been deterred from modifying Vajk as proposed in the Office Action, since to do so would have negated Vajk's intended purpose of providing *secure* communication, in contravention of M.P.E.P. § 2143.01.

The final clauses of claims 1 and 21 recite, substantially:

Said management apparatus, responsive to the reception of the remittance information and the associated depository information, storing the remittance information and the associated depository information to manage the message input by said message input section of said first ATM for financial transactions based upon communication with the message depository via the public communications network.

Neither Vajk, Semple, nor Furumoto teach, disclose, or suggest a "management apparatus, responsive to the reception of the remittance information and the associated depository information, storing the remittance information and the associated depository information to manage the message input by said message input section of said first ATM for financial

transactions based upon communication with the message depository via the public communications network," as recited substantially in claims 1 and 21.

The Office Action acknowledges this deficiency with respect of Vajk further in the first full paragraph at page 6:

Vajk does not disclose management apparatus communicate with message depository via the public communications network.

The Office Action seeks to compensate for this deficiency of Vajk by combining Vajk with Semple and Furuta, saying at page 6 that:

Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify the Vajk's ATM machines modified by Semple's and Japanese Patent HEI 7-31995 to include the feature for the purpose of providing more convenient in communication via the public communication network.

Modifying Vajk to allow a management apparatus to communicate with a message depository via the public communications network, however, conflicts with Vajk's intended purpose of providing *secure* communication, as discussed above, and is therefore prohibited by M.P.E.P. § 2143.01.

It is submitted, therefore, that persons of ordinary skill in the art who read Vajk for all it contains at the time the invention was made would have been deterred from modifying Vajk as proposed in the Office Action, since to do so would have negated Vajk's intended purpose of providing *secure* communication, in contravention of M.P.E.P. § 2143.01.

Similarly, the proposed modification of Vajk at page 5 of the Office Action to add voice and image information to a remittance transaction also conflicts with Vajk's purpose of providing simple text communications to remote locations, and is therefore prohibited by M.P.E.P. § 2143.01 as well. Voice and image information would not be, presumably, simple text communications.

M.P.E.P. § 2143.01 also prohibits a proposed modification that would change the principle of operation of a reference. As provided therein:

If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

Vajk intends to use the existing networks of ATM and POS terminals together with the national and regional clearing house networks or transaction switches that interconnect the various ATM and POS systems. In particular, as described at column 2, lines 18-23:

The system of the present invention advantageously uses the existing networks of ATM and POS terminals together with the national and regional clearing house networks or transaction switches that interconnect the various ATM and POS systems to provide wide public access to electronic mail services.

Modifying Vajk to include Internet access as proposed in the Office Action, on the other hand, would change Vajk's principle of using the existing networks of ATM and POS terminals together with the national and regional clearing house networks or transaction switches that interconnect the various ATM and POS systems. Since the proposed modification would change the principle of operation of Vajk, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*. Claims 1 and 21 are submitted to be allowable. Withdrawal of the rejection of claims 1 and 21 is earnestly solicited.

Claims 2-20 and 22-40 depend from claim 1 or claim 21, respectively, and add additional distinguishing elements. Claims 2-20 and 22-40 are thus also submitted to be allowable. Withdrawal of the rejection of claims 2-20 and 22-40 is earnestly solicited.

Claim 41:

The second clause of claim 41 recites:

Inputting a message for a remittance destination during a remittance financial transaction at an automated teller machine (ATM) to perform a financial transaction.

Neither Vajk, Semple, nor Furumoto teach, disclose, or suggest inputting a message for a remittance destination during a remittance financial transaction at an automated teller machine (ATM) to perform a financial transaction, as discussed above with respect to the rejections of claims 1 and 21. Thus, even if the references were combined as proposed in the Office Action, the claimed invention would not result.

The third clause of claim 41 recites:

Sending the message for storage from the ATM to a message depository via a public communications network, said message depository, responsive to the reception of the message, storing the message therein.

The Office Action acknowledges that Vajk shows no "sending the message for storage from the ATM to a message depository via a public communications network, said message depository, responsive to the reception of the message, storing the message therein," as discussed above with respect to the rejections of claims 1 and 21. Persons of ordinary skill in the art who read Vajk for all it contains at the time the invention was made would have been deterred from

modifying Vajk as proposed in the Office Action, as also discussed above with respect to the rejections of claims 1 and 21.

The third clause of claim 41 recites:

The management apparatus, responsive to the reception of the remittance information and the associated depository information, storing the remittance information and the associated depository information to manage the message input by said message input section of said first ATM for financial transactions based upon communication with the message depository via the public communications network.

The Office Action acknowledges that Vajk shows no "management apparatus, responsive to the reception of the remittance information and the associated depository information, storing the remittance information and the associated depository information to manage the message input by said message input section of said first ATM for financial transactions based upon communication with the message depository via the public communications network," as discussed above with respect to the rejections of claims 1 and 21. Persons of ordinary skill in the art who read Vajk for all it contains at the time the invention was made would have been deterred from modifying Vajk as proposed in the Office Action, as also discussed above with respect to the rejections of claims 1 and 21. Claim 41 is thus submitted to be allowable, for at least those reasons discussed above with respect to the rejections of claim 1 and 21. Withdrawal of the rejection of claim 41 is earnestly solicited.

Conclusion:

Accordingly, in view of the reasons given above, it is submitted that all of claims 1-41 are allowable over the cited references. Allowance of all claims 1-41 and of this entire application is therefore respectfully requested.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

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If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

STAAS & HALSEY LLP

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